

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 11-20 are presently pending in this application, Claims 11, 15, 16, 18 and 19 having been amended by the present amendment.

In the outstanding Office Action, Claims 11 and 16 were rejected under 35 U.S.C. 112, second paragraph; and Claims 11-15 and 18-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Ashby et al. (US. Patent 5,911,723). However, Claims 16 and 17 were indicted as being allowable if rewritten to overcome the rejection under 35 U.S.C. 112, second paragraph and / or in independent form. Applicant acknowledges with appreciation the indication of allowable subject matter.

Amended Claims 11, 15, 16, 18 and 19 are fully supported by the specification, drawings and claims as originally filled.¹ Hence, no new matter is believed to be added thereby.

In response to the rejection of Claims 11 and 16 under 35 U.S.C. 112, second paragraph, Claims 11 and 16 have been amended to provide sufficient antecedent basis. Accordingly, Claims 11 and 16 are now believed to be in full compliance with the requirements of 35 U.S.C. 112, second paragraph.

Briefly recapitulating, Claim 11 is directed to an apparatus for measuring a joint gap and ligament balance between an osteotomized surface at a distal end of a femur and an osteotomized surface at a proximal end of a tibia. For example, referring to the non-limiting embodiment of Figs. 1, 6 and 9, the apparatus includes a base 10, a first engaging member 14 for an engagement with the osteotomized surface at the proximal end of the tibia, a first arm 12, a moving body 18,

¹ The present application, for example, Figs. 1, 6 and 9.

a second engaging member 22 for an engagement with the osteotomized surface at the distal end of the femur, and a second arm 20. The first arm 12 obliquely connects the base 10 and the first engaging member 14 to have a structure in which the base 10 is configured to be positioned outside an area right in front of the tibia. The second engaging member 22 is rotatable about an axis substantially parallel with respect to the osteotomized surface at the distal end of the femur. The second arm obliquely connects the moving body and the second engaging member to have a structure in which the moving body is configured to be positioned outside an area right in front of the femur.

In the apparatus recited in Claim 11, the first arm obliquely connects the base and the first engaging member to have a structure in which the base is configured to be positioned outside an area right in front of the tibia, and the second arm obliquely connects the moving body and the second engaging member to have a structure in which the moving body is configured to be positioned outside an area right in front of the femur. Namely, the apparatus recited in Claim 11 has a structure wherein the base is configured not to be positioned right in front of the tibia, and wherein the moving body is configured not to be positioned right in front of the femur.

For example, referring to Fig. 9, the base 10 and the moving body 18 do not hinder that the patellar tendon L is located at its original position (anterior position) as shown by the line P in Fig. 9. In other words, a gap measurement by the tensor according to the present invention recited in Claim 11 is done at a physiological intrinsic position of patella. Namely, a gap measurement by a tensor is done at two positions, that are an extended condition where the flat osteotomized surface of the tibial bone is parallel with respect to the flat osteotomized surface FA at the end of the femoral bone as shown in Fig. 7 and a flexed condition where the flat osteotomized surface FB on the rear side of the femoral bone is parallel with respect to the flat osteotomized surface of the tibial bone as shown in Fig. 8. According to the present invention

recited in Claim 11, these measurements at these two positions are done without patella eversion, i.e., an original physiological position of patella. Thus, the tensor according to the present invention recited in Claim 11 can realize a physiologically idealized measurement.²

Consequently, in the apparatus according to the present invention recited in Claim 1, **measuring operation can be performed without patella eversion**, because the base is not positioned right in front of the tibia, and the moving body is not positioned right in front of the femur during the measuring operation.

The Office Action asserts that Ashby et al. disclose the present invention. However, Applicant notes that a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil Co. of Californial, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, Ashby et al. clearly do not meet each and every limitation of Claim 11.

The Office Action asserts Ashby et al. disclose an apparatus having a base (1), a first engaging member (3), a moving body (4), second engaging member (5), moving member (33), driving member (17), a locking member (18), a first indicator (33), and a second indicator (9 and 11).³ The Office Action further asserts Ashby et al. disclose the engaging members having an offset structure with respect to the base and moving body.⁴

However, Ashby et al. fail to disclose that the first arm obliquely connects the base and the first engaging member to **have a structure in which the base is configured to be positioned outside an area right in front of the tibia**, and the second arm obliquely connects the moving

² See the present specification, page 16, line 17 to page 17, line 26.

³ See the outstanding Office Action, page 3, lines 9-6 from the bottom.

⁴ See the outstanding Office Action, page 4, lines 2-4.

body and the second engaging member to **have a structure in which the moving body is configured to be positioned outside an area right in front of the femur.**

Although the Office Action further asserts Ashby et al. disclose the engaging members are offset from the rest of the invention using the shaft 24 as a center line, in the Ashby et al. apparatus, as shown in FIG. 12 of Ashby et al., the base (1) and the moving body (4) are **positioned inside an area right in front of the tibia and femur.** Namely, the base 1 and the moving body 4 do hinder that the patellar tendon is located at its original position. Therefore, in the Ashby et al. apparatus, measuring operation requires patella eversion because the apparatus interferes with a patella (see Figs. 3 and 12).

Accordingly, Ashby et al. are not believed in any way to anticipate the specific features recited in Claim 11. Therefore, Claim 11 is believed to be allowable.

Likewise, independent Claim 15 includes subject matter substantially similar to what is recited in Claim 11 to the extent discussed above. Thus, Claim 15 is also believed to be allowable.

Dependent Claims 12-14 depend directly from Claim 11, and dependent Claims 16-20 depend directly or indirectly from Claim 15. Accordingly, substantially the same arguments as set forth above with regard to Claim 11 also apply to dependent Claims 12-14 and 16-20. Hence, each of the dependent claims is also believed to be allowable.

Consequently, in view of the present amendment, it is respectfully submitted that this application is in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully Submitted,

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